

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** JOHN R. KLUG

\_\_\_\_\_  
Appeal No. 95-4544  
Application 07/975,905<sup>1</sup>

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ON BRIEF  
\_\_\_\_\_

**MAILED**

**DEC - 4 1997**

**PAT.&T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Before HAIRSTON, KRASS, and FLEMING, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

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<sup>1</sup> Application for patent filed November 12, 1992.  
According to appellant, the application is a continuation of  
Application 07/397,996, filed August 23, 1989.

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 1 through 11, 13 through 15, 17 through 23, 25, and 26. Claims 12, 16, and 24 have been canceled. Appellant filed an after final amendment on November 14, 1994 amending claims 1, 2, 9, 10, 11, and 23, adding claims 27 and 28 and canceling claims 18 through 22. We note that this after final amendment has been entered. In the Examiner's answer, the Examiner rejects claims 1 through 11, 13 through 15, 17, 23, and 25 through 28.

The invention relates to a system and method which permit any or all of a plurality of users at remotely located personal computers to edit a file resident in one of the computers.

Independent claim 1 is reproduced as follows:

1. A computer file editing system for a plurality of users at different remote locations, comprising:

a plurality of personal computers, one for each of the users, each of said plurality of personal computers including computer file display means, at least one of said personal computers being designated host computer for given file editing operations and having multi-tasking processing means for coordinating the execution of said file editing operations comprising edits of less than the entirety of a given computer file inputted by at least the user of one of said personal computers, and for coordinating the transfer of data corresponding with and limited to said file editing operations from said host computer to the display means of the others of said plurality of personal computers whereby said file editing operations and said corresponding limited data transfer are performed in a predetermined manner by said host computer; and

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interconnecting means for electrically interconnecting said host computer with the others of said plurality of personal computers to permit transmission of electrical signals corresponding with said file editing operations therebetween;

wherein said plurality of users are permitted to concurrently view said given computer file and, subject to practical system limitations, said computer file display means, multi-tasking processing means and interconnecting means operate so that said file editing operations and said corresponding limited data transfer to said display means occur on a substantially real-time basis relative to said edit inputs to permit said plurality of users at said different remote locations to review with their respective display means said edits made to said given computer file substantially contemporaneously with the corresponding input of said edits and execution of said file editing operations.

The Examiner relies on the following reference:

Jakobs et al. (Jakobs)                      5,300,943                      Apr. 5, 1994  
(effective filing date Oct. 3, 1986)

Claims 1 through 11, 13 through 15, 17, 23, and 25 through 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Jakobs<sup>2</sup>.

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<sup>2</sup> We note that in the Examiner's answer, the Examiner withdrew the rejection of claims 1 through 11, 13 through 15, 17 through 23, 25, and 26 under 35 U.S.C. § 103 as being unpatentable over Bly and Kaufman and set forth this rejection as a new ground of rejection.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the briefs<sup>3</sup> and answers<sup>4</sup> for the respective details thereof.

### **OPINION**

We will not sustain the rejection of claims 1 through 11, 13 through 15, 17, 23, and 25 through 28 under 35 U.S.C. § 103.

The Examiner has failed to set forth a ***prima facie*** case. It is the burden of the Examiner to establish why one having

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<sup>3</sup> Appellant filed an appeal brief on March 10, 1995. We will refer to this appeal brief as simply the brief. Appellant filed a reply appeal brief on August 15, 1995. We will refer to this reply appeal brief as the reply brief. The Examiner responded to the reply brief with a Supplemental answer, thereby entering and considering the reply brief. Appellant filed a supplemental reply appeal brief on December 4, 1995. We will refer to this reply appeal brief as the supplemental reply brief. In a second supplemental answer, the Examiner stated that the supplemental reply brief is entered and considered, but no further response by the Examiner is deemed necessary.

<sup>4</sup> The Examiner responded to the brief with an Examiner's answer, mailed May 10, 1995. We will refer to the Examiner's answer as simply the answer. The Examiner responded to the reply brief with a supplemental Examiner's answer, mailed September 29, 1995. We will refer to the supplemental Examiner's answer as simply the supplemental answer. The Examiner responded to the supplemental reply brief with a second supplemental Examiner's answer, mailed December 14, 1995.

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ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordinance Mfg. Inc. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), ***cert. denied***, 117 S. Ct. 80 (1996) ***citing W.L. Gore & Assocs., Inc. v. Garlock, Inc.***, 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311-13 [sic] (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984).

Appellant argues in the reply brief and supplemental reply brief that Jakobs fails to teach or suggest the use of personal computers. Appellant further emphasizes in the reply brief and the supplemental reply brief that Jakobs fails to teach the specific structure as recited in claim 1. In particular, Appellant states on page 11 of the reply brief that Jakobs fails to teach the following limitations:

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1) the system includes at least one host PC having a multi-tasking processing means which is multifunctional, namely a host PC which both coordinates the execution of file editing operations input by at least one of the plurality of users and the transfer of data, limited to the edits, from the multi-tasking PC directly to the displays of all of the PCs within the computer file editing system; and

2) a plurality of users at remote locations are able to concurrently view the same portion of the computer file on their respective displays, including any edits made to the subject computer file by at least one of the users, and these edits are provided to all of the displays on a substantially real-time basis such that each user sees the edits substantially contemporaneously with the inputting of the same.

The Examiner agrees on page 3 of the supplemental answer that Jakobs does not teach the use of personal computers as the workstations in the Jakobs system. The Examiner further states on page 4 of the supplemental answer the following:

Jakobs did not specifically teach that at least one of the personal computers was to be designated the host computer for given file editing operations, and having multi-tasking processing means for coordinating the execution of said file editing comprising edits of less than the entire file inputted by at least one of the users, and for coordinating the transfer of data corresponding with, and limited to, the file editing operations from the host computer to the display means for the others of the plurality of personal computers whereby the file editing operations and corresponding limited data transfer are performed in a predetermined manner by the host computer.

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Upon a careful review of Jakobs, we fail to find that the references teach the above limitations as recited in Appellant's claim 1.

The Examiner argues that these limitations are well known in the art to the skilled artisan. However, the Examiner has not provided a reference or an affidavit as evidence of these statements. We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a **prima facie** case. **In re Knapp-Monarch Co.**, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); **In re Cofer**, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

Furthermore, we fail to find any suggestion of modifying Jakobs to provide a computer file editing system as recited in Appellant's claim 1. The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." **In re Fritch**, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), **citing In re Gordon**, 733

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F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).


"Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." **Para-Ordnance**

**Mfg., supra.**

We note that the remaining claims set forth these limitations as discussed for claim 1. Therefore, we have not sustained the rejection of claims 1 through 11, 13 through 15, 17, 23 and 25 through 28 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

**REVERSED**

  
KENNETH W. HAIRSTON )  
Administrative Patent Judge )

  
ERROL A. KRASS )  
Administrative Patent Judge )

  
MICHAEL R. FLEMING )  
Administrative Patent Judge )

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